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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,325	02/07/2001	Bruce S. Marks	A1019/20268	4861

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT PAPER NUMBER

1774

DATE MAILED: 11/05/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/778,325

Applicant(s)

MARKS, BRUCE S.

Examiner

Lawrence D Ferguson

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1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 21-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6/16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment mailed August 21, 2003. Claims 16 and 18 were cancelled and claims 21-26 were added rendering claims 1-15, 17 and 19-26 pending in this case.

### ***Claim Rejections – 35 USC § 103(a)***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alder et al. (U.S. 5,773,136).

Alder discloses a polyolefin, opaque, pigmented, and biaxially oriented film comprising a heat-sealable layer, a non-voided intermediate layer (non-voided skin layer), an optionally voided base layer (core layer) along with a voided polymeric layer (claims 1, 16 and 18 and column 1, lines 41-45) and a metal layer (column 4, lines 37-39). Alder further discloses a base layer (core layer), with layers on a first surface of the base layer and a layer on the second surface of the base layer (column 4, lines 13-22). Alder discloses that the outer surfaces of the film are corona discharge treated (column 4, line 60 to column 5, line 3) where column 3, lines 59-65 shows that the layers of the

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film can be voided by comprising calcium carbonate (column 6, lines 32-37). In instant claim 1, the phrases, 'oxidatively treated to receive a metal layer thereon' and 'to adhere a label to a container' introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. Additionally, in instant claim 1, the phrase, 'to provide sufficient porosity for the absorption of an aqueous cold glue adhesive' is directed to intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). Further, since the outer layer can be voided, it can provide sufficient porosity for absorption of aqueous cold glue.

Although Alder discloses that the amount of calcium carbonate causes the voiding, the reference does not specifically teach the concentrations of the calcium carbonate as in instant claims 2-5 or the thicknesses as in instant claims 12-13. However, such concentrations and thicknesses are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the

concentrations and thicknesses, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. concentrations and thicknesses) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they control the level of voiding, mechanical strength and opacity of the film. As such, they are optimizable. It would have been obvious to one of ordinary skill in the art to make the film with the limitations of the concentrations and thicknesses since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

***Claim Rejections – 35 USC § 103(a)***

4. Claim 20 is rejection under 35 U.S.C. 103(a) as being unpatentable over Alder et al. (U.S. 5,773,136) in view of Murschall et al. (U.S. 5,900,294).

Alder is relied upon as above for claims 1 and 17. Alder does not specifically show that the film can be used as a label as in instant claim 20. Murschall shows a white, opaque label comprising a base layer and at least one outer layer comprising calcium carbonate (claims 1-7). It would have been obvious to one of ordinary skill in the art to use the film of Alder as a label since it is known that films of the composition of Alder and Murschall can be used as labels since such films have unusually low heat-sealing temperatures (Murschall, column 7, lines 23-30).

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hill, IV discloses a metallized film being an opaque label (claims 4-5) where the label is applied to a container using a cold glue adhesive (column 2, lines 1-10).

6. Newly added claims 21-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

7. Applicant's argues with respect to claims 1-15, 17 and 19 have been considered but are found unpersuasive. Applicant argues 'to provide sufficient porosity for the absorption of an aqueous cold glue adhesive of the type employed to adhere a label to a container' is not a product by process. 'To provide sufficient porosity for the absorption of an aqueous cold glue adhesive' is an intended use, which is given little patentable weight. Additionally, the phrase, 'to adhere a label to a container' introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. Further, process limitations are given no patentable weight in product claims. Applicant argues claim 1 reads the voided outer skin layer is *intended* to receive the aqueous cold glue adhesive thereon. The intended receipt of aqueous cold glue adhesive is not part of the multilayer material. Applicant narrows the multilayer film

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to include aqueous cold glue adhesive in newly added claims 21-26, which are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 1 fails to actually include this limitation, but suggests the film can absorb aqueous cold glue adhesive, which speaks to the capability of the film. This is a 'capable of' limitation and such a recitation that an article is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

Applicant argues Alder discloses a structure where the intermediate layer is non-voided. Applicant acknowledges that the base layer of Alder is analogous to the claimed 'core layer'. Examiner directs Applicant to column 3, lines 59-65, which shows, that the layers of the film can be voided, by comprising calcium carbonate (column 6, lines 32-37). Furthermore, providing sufficient porosity, is an intended use of the claimed invention, which is given little patentable weight. Applicant argues Alder does not remotely suggest a film intended to be used with an aqueous cold glue adhesive. The intended receipt of aqueous cold glue adhesive is not part of the multilayer material. Applicant narrows the multilayer film to include aqueous cold glue adhesive in newly added claims 21-26, which are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 1 fails to actually include this limitation, but suggests the film can absorb aqueous cold glue adhesive.

Applicant fails to provide reasons why Alder in view of Murchall is unobvious, so the rejection over instant claim 20 is maintained for reasons of record.

**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
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